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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,602	02/18/2004	Baruch Gedalia	006379.00005	2672
22908 7590 05/27/2009 BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606				
EXAMINER				
PAINTER, BRANON C				
ART UNIT		PAPER NUMBER		
3633				
MAIL DATE		DELIVERY MODE		
05/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/781,602

**Applicant(s)**

GEDALIA ET AL.

**Examiner**

BRANON C. PAINTER

**Art Unit**

3633

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,10-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

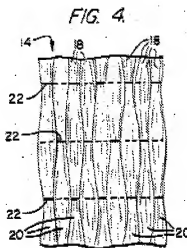
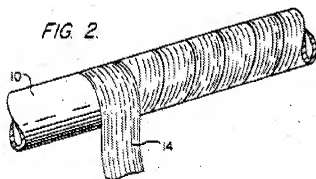
2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 1, 2-3, 5-8, 10, 12-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawley (4,676,276) in view of Nishimura et al. (5,758,796).
  4. Regarding claims 8 and 17:
    - a. Fawley discloses a tank reinforced against seismic and paraseismic stresses including:
      - i. A metal tank with a base capable of lying of the ground (either circular cross-sectional end of 10, Fig. 2), an external surface with a height from the base, and a longitudinal axis [claim 8] comprising a generally cylindrical tank [claim 17] (10, Fig. 2; Abstract).

- ii. The tank surrounded over at least part of its height with fiber fabric (14, Fig. 2) bonded to the external surface of the tank (c. 4, 54-58).
  - iii. The fabric placed in bands extending substantially around the entire circumference of the tank in a direction substantially perpendicular to the container axis, with the fibers of the fabric extending predominantly in a direction substantially perpendicular to the container axis (Figs. 2, 4; c. 4, 10-15).
- b. Fawley discloses the claimed invention wherein the fiber fabric is made from glass fibers instead of carbon fibers. Nishimura shows that glass fibers and carbon fibers an equivalent structure known in the art or reinforcing metal containers (c. 3, 37-39). Therefore, because these two reinforcement fibers were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the carbon fibers of Nishimura for the glass fibers of Fawley.
- c. The examiner notes it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.
- d. The examiner notes that claim 17 is considered to be a product-by-process claim due to the phrase "passively bonded". The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product in the

product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).



Reproduced from Fawley

5. Regarding claim 10, Fawley/Nishimura as modified above discloses a metal tank reinforced with carbon fibers, with Fawley further disclosing a tank at least partly filled when wrapped with fabric (10 is filled with air, Fig. 2).
6. Regarding claim 12, Fawley/Nishimura as modified above discloses a metal tank reinforced with carbon fibers, with Fawley further disclosing fabric bonded in several superposed layers (c. 3, 32-33; c. 4, 10-15; c. 8, 17-19).
7. Regarding claim 13, Fawley/Nishimura as modified above discloses a metal tank reinforced with carbon fibers, with Fawley further disclosing a number of superposed layers varying with the container height (c. 4, 10-15; This passage states that when wrapping the overlap can be between 1-50%. For an overlap of 10%, the overlap portions are of greater thickness than the non-overlap portions).

8. Regarding claim 14, Fawley/Nishimura as modified above discloses a metal tank reinforced with carbon fibers, with Fawley further disclosing superposed layers offset by half the width of a band (50% overlap; c. 4, 10-15).
9. Regarding claims 1, 3-7, and 15, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.
  - a. Regarding claim 15, Fawley further discloses the limitation of passively surrounding the container with fiber fabric (c. 7, 42-55).
10. Claims 4 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Fawley/Nishimura as applied to claims 1, 2-3, 5-8, 10, 12-15, and 17 above, and further in view of Toth et al. (4,614,279).
11. Regarding claim 11:
  - a. Fawley/Nishimura discloses a metal tank reinforced with carbon fibers as set forth above.
  - b. Fawley/Nishimura does not expressly disclose bonding the carbon fiber fabric to the tank in such a manner to bypass regions projecting from the surface.
  - c. Toth discloses a region projecting from a tank surface, and fibers wrapped in a way that bypasses the container surface projection (c. 1, 51-62).
  - d. The examiner notes that it is notoriously well-known for tanks such as Fawley to include secondary pipes projecting from the surface thereof, to carry the contents of the pipe in a secondary direction.

- e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the carbon fiber fabric of Fawley/Nishimura to bypass any tank surface projections present as taught by Toth, in order to provide reinforcement to the area near such a projection.
12. Regarding claim 4, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination

### ***Response to Arguments***

13. Applicant's arguments filed 03/11/09 have been fully considered but they are not persuasive.
14. Applicant argues that Fawley does not concern a tank as does the instant invention, but rather concerns a pipe. However, the Examiner notes that Fawley discloses all the structure of the tank claimed by Applicant. The Examiner further notes that Fawley, in its broadest reasonable interpretation, can be considered a "tank," as it meets the dictionary definition of "tank" by being a large container for holding liquid.
15. Applicant argues that Fawley is associated with dynamic liquid flow while the instant invention is associated with static liquid. However, the Examiner notes that Applicant's claims are directed only to a tank and its support structure, and that the combination of Fawley/Nishimura meets all the claim limitations.
16. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., static vs. dynamic liquid) are not recited in the rejected claim(s). Although the

claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. Applicant argues that the fractures against which the Fawley is protected are caused by fluid flow, while the instant invention has deformities caused by seismic and paraseismic events. However, Applicant is claiming a tank "reinforced against seismic or paraseismic stresses." While Fawley may reinforce his tank for a different reason, the reinforcing fibers of Fawley would most certainly provide some amount of reinforcement against seismic or paraseismic stresses, thus meeting the claim limitations.
18. In response to applicant's argument that Fawley is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Fawley and the instant invention concern the reinforcement of cylindrical containers.
19. Applicant argues that Fawley is nonanalogous to the instant invention, and that hindsight would be necessary to arrive at the instant invention from Fawley. However, Fawley and the instant invention both concern reinforcement of cylindrical containers, and the only difference in Fawley and the claimed invention is fibers of carbon, which Nishimura teaches are equivalent to the glass fibers of Fawley. The



Examiner notes that nowhere has Applicant argued against the combination used to reject the claims.

20. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

21. The examiner notes that a tank is defined as "a large receptacle, container, or structure for holding liquid or gas" (Dictionary.com).
22. The examiner notes that a container is defined as "anything that contains or can contain something" (Dictionary.com).
23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then

the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is (571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3633

/B. C. P./

Examiner, Art Unit 3633

/Basil Katcheves/

Primary Examiner, Art Unit 3635